

First, MPEP §2106(II)(C) makes no reference to the language "capable of." Rather, MPEP §2106(II)(C) simply states that "[t]he following are examples of language that may raise a question as to the limiting effect of the language in a claim: (1) statements of intended use or field of use, (B) 'adapted to' or 'adapted for' clauses, (C) 'wherein' clauses, or (D) 'whereby' clauses."

Second, because MPEP §2106(II)(C) makes clear that claim language may raise a question as to the limiting effect of the language in a claim. The Office Action has provided no argument or evidence that the "capable of" language in claims 1, 12, and 16, in fact raises any question as to the limiting effect of the language in a claim.

Third, the clear focus of MPEP §2106(II)(C) is to educate examiners on the possibility that certain language in a claim may only "suggest or make optional" a feature, rather than affirmatively recite the feature. The "capable of" features of claims 1, 12, and 16, do not "suggest or make optional" anything or raise any question as to the limiting effect of the language in the claim. In each of claims 1, 12, and 16 the "capable of" features affirmatively require that the recited "navigation apparatus" be "capable of performing route guidance based on recorded map data." That is, the recited "navigation apparatus" must be structured or purposely programmed to perform route guidance based on recorded map data.

Fourth, in view of the above, the skilled artisan would immediately understand that recording updated map data or a program that is only made usable by a release key in a navigation apparatus which is incapable of performing route guidance based on recorded map data would not infringe this feature of claims 1, 12, and 16, and recording updated map data or a program that is only made usable by a release key in a navigation apparatus which is capable of performing route guidance based on recorded map data would infringe this feature of claims 1, 12, and 16. Thus, the "capable of" feature of claims 1, 12, and 16, clearly and

definitely provides notice to the public of what constitutes infringement as required by 35 U.S.C. §112, second paragraph (see MPEP §2173).

In view of at least the foregoing, claims 1, 12, and 16 are definite under 35 U.S.C. §112, second paragraph. Accordingly, the rejection of claims 1, 12, and 16, and their dependents, is improper. Applicants respectfully request withdrawal of the rejection.

Claims 1, 5, 6, 12, and 16 are rejected under 35 U.S.C. §101 as allegedly non-statutory. Applicants respectfully traverse the rejection.

In support of the rejection, the Office Action relies exclusively on the USPTO's "Interim Guidelines for Examination of Patent Applications for Patent Subject Matter Eligibility," Annex IV, which has been recently incorporated into MPEP §2106.01. However, the Office Action's reliance on Annex IV and/or MPEP §2106.01 is misplaced.

Annex IV and MPEP §2106.01 only apply to functional vs. non-functional descriptive material. Importantly, Annex IV and MPEP §2106.01 deal with a 35 U.S.C. §101 judicial exception to the enumerated categories of patentable subject matter under 35 U.S.C. §101 for the practical application of an abstract idea, that would not otherwise fall within the specifically enumerated categories of patentable subject matter under 35 U.S.C. §101 (See MPEP §§ 2106(IV)(A) and 2106(C)(1)). However, each of claims 1, 5, 6, 12, and 16 fall within a specifically enumerated category of patentable subject matter under 35 U.S.C. §101.

Specifically, claims 1, 5, 6, and 12 are directed to "processes"; that is, they require acts to be performed. Claim 16 is directed a "machine," and is drafted in the accepted format of a means-plus-function claim under 35 U.S.C. §112, sixth paragraph (see MPEP §2181). Importantly, because claims 1, 5, 6, 12, and 16 are directed to enumerated categories of statutory subject matter in 35 U.S.C. §101, they recite statutory subject matter. Furthermore, because claims 1, 5, 6, 12, and 16 are directed to enumerated categories of statutory subject matter in 35 U.S.C. §101, any discussion of judicial exceptions to the enumerated categories

of patentable subject matter under 35 U.S.C. §101 for the practical application of an abstract idea is irrelevant.

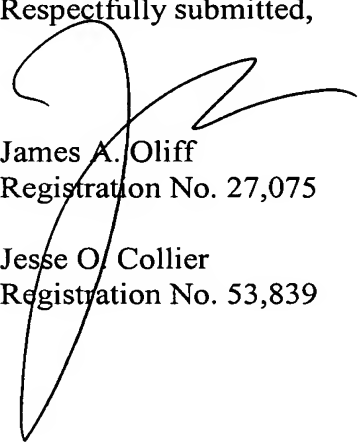
Accordingly, the rejection of claims 1, 5, 6, 12, and 16 under 35 U.S.C. §101 is improper. Applicants respectfully request withdrawal of the rejection.

Finally, because linking claim 16 and generic claim 1 are allowable for the reasons discussed above, Applicants respectfully request rejoinder and prompt allowance of withdrawn claims 2-4, 7-11, and 15, as required by MPEP §821.04.

In view of at least the foregoing, Applicants respectfully submit that this application is in condition for allowance. Applicants earnestly solicit favorable reconsideration and prompt allowance of the pending claims.

Should the Examiner believe that anything further would be desirable in order to place this application in even better condition for allowance, Applicants invite the Examiner to contact the undersigned at the telephone number set forth below.

Respectfully submitted,

  
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